

## **REMARKS**

Claims 1-45 are pending in the present application. Reconsideration of the claims is respectfully requested.

### **I. 35 U.S.C. § 112, Second Paragraph**

The Office Action rejects claims 1-45 under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to explicitly define the unique characteristics of the disclosure with respect to the current art. This rejection is respectfully traversed.

The Office Action quotes the second paragraph of 35 U.S.C. § 112 as follows:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

However, it is respectfully submitted that the Office Action proffers no analysis as to why the claims fail to define the invention. In fact, the Office Action does not present a rejection under 35 U.S.C. § 102 indicating that the claims recite the invention of another

Applicants submit that, contrary to the Office Action's assertions, as required by 35 U.S.C. § 112, claims 1-45 point out and distinctly claim the subject matter which the **applicant** regards as the invention. That is, contrary to the Office Action's assertions, there is no requirement under § 112(2) that the claims address the "current art."

For at least the above reasons, Applicants submit that this rejection of claims 1-45 under 35 U.S.C. § 112 is groundless. The above arguments were made in the response filed July 23, 2003. Yet, the arguments are not addressed in the Office Action. As such, the Office Action still fails to establish any grounds whatsoever for such a rejection and this rejection should be withdrawn.

### **II. 35 U.S.C. § 103, Obviousness**

The Office Action rejects claims 1-45 under 35 U.S.C. § 103 as being unpatentable over *Geller et al.* (US Pat. No: 6,236,990) in view of *Walker et al.* (US Pat. No: 6,131,086) and further in view of *Ojha et al.* (US Pat. No: 6,598,026). This rejection is respectfully traversed.

With respect to every pending claim, the Office Action states:

As per claims 1-45 Geller teaches a method of presenting information on products and ranking these products (Abstract)(Fig 2A)(Fig 2B) and calculating user preferences (Fig 3) through filtering as well as calculating rankings and scores (col 8 lines 27-48) of products based on consumer interests. Geller further teaches a preference calculator (Fig 2A/230), and evaluation storage (Fig 2A/218) and an attribute display module (Fig 2A/222) and a product data display module (Fig 2A/220) and product selection storage (Fig 2A/250) as well as scoring products by name (Fig 2B) and placing orders (Fig 3/342). Walker teaches permitting users to purchase products (Abstract)(Fig 7)(Fig 8) of all varieties (col 3 lines 18-29) and a variety of vendors (col 5 lines 35-50) as well as allocating purchasing time for the products (Fig 11A)(Fig 11B)(col 7 lines 30-44). Walker further teaches a product database (Fig 6) and a product description for specific products (Fig 6/630) and availability (Fig 6/645) and a product cost (Fig 6/640) as well as processing orders by customers (Figs 11a-11c). It would have been obvious to one of ordinary skill in the art at the time of the invention to combine Geller in view of Walker to teach part of the invention. The motivation to combine is to teach a system for making products available to users as enunciated by Walker (col 2 lines 3-5). Ojha teaches a method for facilitating a transaction between a buyer and seller for a product via the Internet (Abstract)(Fig 1-18)(col 2 line 46-col 8 line 32) as well as a buyer placing bids to sellers (Fig 2/210) and negotiation (Fig 2/214) including offers and counteroffers (Fig 2a) and product searching (Fig 3) through graphical user interfaces. Ojha further teaches displaying products by manufacturer and type (Fig 6) and product details and prices of all merchants (Fig 8) where a customer may bid as well as placing bids (Fig 9) and a listing of bids and asks between the parties (Fig 11) and a compilation of the number of bids above threshold prices (Fig 12) and a listing of the business rules to the merchants (Figs 13A-13D). It would have been obvious to one skilled in the art at the time of the invention to combine Geller in view of Walker and further in view of Ojha. The motivation to combine Ojha in view of Geller and Walker is to teach a method for buyers to negotiate online with sellers for products as enunciated by Ojha (col 2 lines 40-44).

Office Action, dated October 9, 2003. Applicants respectfully disagree. In fact, Applicants submit that *Geller*, *Walker*, and *Ojha* alone or in combination, do not disclose the features recited in the claims.

Instead, *Geller* merely teaches a method and system for ranking products according to a user's preferences. The method and system of *Geller* include a catalog of products, which are evaluated by experts who can compare each of the products and how

they rate with respect to certain attributes. See col. 2, lines 18-46. Products may then be ranked according to score presented on a display. See FIG. 2B.

*Walker* merely teaches a method and system for allowing television viewers to purchase products seen on a television program. The method and system of *Walker* includes a call center, which viewers may call to purchase products. The products are associated with a program, including a time within the program in which the product appeared. For example, if a viewer sees a television personality spill coffee on his suit, the viewer may call the call center and purchase the suit featured in the program. The operator references a database to locate the product information associated with the television program. See FIG. 6; col. 5, lines 10-34.

*Ojha* teaches a method and apparatus for brokering transactions between a buyer and one of a plurality of sellers. A bid from a buyer for a product is made available via the Internet to a seller associated with the product. The seller may then submit an acceptance of the bid or a counteroffer. See Abstract. Product information, list prices, ask prices, and bid prices are filtered and listed on a display of a buyer. See Fig. 9; col. 11, lines 14-57. Current bids and quote solicitations are filtered and listed on a display of a merchant. See Fig. 11; col. 12, lines 3-27.

In contradistinction, the present invention, as set forth in claim 1, for example, recites:

1. A method of presenting information via a digital device having presentation resources, comprising:
  - receiving bids for the presentation resources of the digital device from a plurality of product/service providers**, wherein each bid identifies a benefit, associated with a product/service of a given product/service provider, offered to a user of the digital device;
  - ranking the bids based on the benefit offered to the user;
  - apportioning the presentation resources of the digital device in accordance with the ranking of the bids;** and
  - presenting information for at least one of the plurality of product/service providers using the apportioned presentation resources.[emphasis added]

It is respectfully submitted that neither *Geller*, *Walker*, nor *Ohja* teaches or suggests at least “receiving bids for the presentation resources of the digital device from a plurality of product/service providers” and “apportioning the presentation resources of the digital

device in accordance with the ranking of the bids,” as recited in claim 1, for example. While *Ojha* does mention that sellers may submit bids, or “counteroffers,” to buyers, there is no teaching or suggestion in *Ojha* receiving bids **for the presentation resources of the digital device**, for example, and there certainly is not teaching or suggestion in *Ojha* of apportioning the presentation resources of the digital device in accordance with the ranking of the bids, as a further example. The applied references, taken alone or in combination, fail to teach or suggest the claimed invention; therefore, at least claim 1 cannot be rendered obvious by a combination of *Geller*, *Walker*, and *Ojha*.

The Office Action specifically states, “[I]t would have been obvious to one of ordinary skill in the art at the time of the invention to combine *Geller* in view of *Walker* to teach part of the invention.” Clearly, the rejection attempting to find pieces or “parts” of the invention and to use Applicants’ disclosure as a template to unite the disparate pieces in the prior art. However, as set forth in *In re Fritch*, 972 F.2d 1260, 23 U.S.P.Q.2d 1780 (Fed. Cir. 1992), such reliance is an impermissible use of hindsight with the benefit of Applicant’s disclosure. That is, as set forth in *In re Fritch*, absent some teaching, suggestion, or incentive in the prior art, *Geller* and *Walker* and *Ojha* cannot be properly combined to form the claimed invention. Such proposed combination can be reached only through an impermissible use of hindsight with the benefit of Applicants’ disclosure as a model for the needed changes. Applicants submit that, contrary to the Office Action’s assertions, the motivation of “to teach a method for buyers to negotiate online with sellers for products,” although loosely paraphrased from the teachings of *Ojha*, does not constitute a suggestion to combine with the “part” represented by the teachings of *Geller* and *Walker*.

More particularly, the bids in *Ojha* are for the purchase, or sale, of a product. The teachings of *Ojha*, as well as the motivation found therein, are not equivalent to the features and functions of claim 1, which recites at least “receiving bids **for the presentation resources of the digital device** from a plurality of product/service providers.”

Furthermore, references are not properly combinable or modifiable if their intended function is destroyed. See *In re Ratti*, 270 F.2d 810, 123 U.S.P.Q. 349 (CCPA 1959), where the court held that, “[i]f the proposed modification or combination of the

prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims *prima facie* obvious.”

In the instant case, the intended function of *Geller* is to allow rank products based upon a certain attribute. As such, a user may rank products by score to identify a product that meets user preferences. On the other hand, the intended function of *Walker* is to make specific products available to television viewers when the product is identified by viewing a television program. There is no specific product identified in *Geller* and there is no need to rank products in *Walker*. At least for these reasons, the references are not combinable.

Adding the functions of *Ojha* to the combination only serves to destroy the intended function of each and every reference. While the intended function of *Ojha* is to allow merchants to make counteroffers, there is only one specific product in *Ojha*, there is no specific product in *Geller*, and there is no need to rank products in *Walker*. Therefore, a person of ordinary skill in the art would find no motivation to add the functions of *Ojha* to the combination of *Geller* and *Walker*.

Independent claims 16 and 32 recite at least the similar subject matter addressed above with respect to claim 1 and are allowable at least for the same reasons. Since claims 5-11, 20-26, 31, and 34-43 depend from claims 1, 16, and 32, at least the same distinctions between *Geller*, *Walker*, and *Ojha* and the invention recited in claims 1, 16, and 32 apply for these claims. Additionally, claims 5-11, 20-26, 31, and 34-43 recite other additional combinations of features not suggested by the reference. Consequently, it is respectfully urged that the rejection of claims 1, 5-11, 16, 20-26, 31, 32, and 34-37 be withdrawn.

Claims 2, 17, and 33 are amended to be in independent form. For example, claim 2 recites:

2. A method of presenting information via a digital device, comprising:
  - transmitting a request for information from at least one product/service provider;
  - filtering out unwanted information from product/service providers;
  - receiving the information from the at least one product/service provider, the information identifying a benefit, associated with a

product/service of the at least one product/service provider, offered to a user of the digital device;

ranking the information based on the benefit offered to the user;

and

presenting the information via the digital device in accordance with the ranking of the information such that higher ranking information is presented more prominently than lower ranking information.

It is respectfully submitted that neither *Geller*, *Walker*, nor *Ojha* teaches or suggests at least “transmitting a request for information from at least one product/service provider” and “**filtering out unwanted information** from product/service providers,” as originally presented in claim 2. In fact, these features are not addressed in the Office Action. The Office Action fails to establish a *prima facie* case of obviousness for claim 2. The applied references, taken alone or in combination, fail to teach or suggest each and every claim limitation. Therefore, it is respectfully submitted that the rejection is improper and should be withdrawn.

Independent claims 17 and 33 recite at least similar allowable subject matter addressed above with respect to claim 2 and are allowable for the same reasons. At least because claims 3, 4, 12-15, 18, 19, 27-30, and 38-40 depend from claims 2, 17, and 33, at least the same distinctions between *Geller*, *Walker*, and *Ojha* and the invention recited in claims 2, 17, and 33 apply for these claims. Additionally, claims 3, 4, 12-15, 18, 19, 27-30, and 38-40 recite other additional combinations of features not suggested by the reference. Consequently, it is respectfully urged that the rejection of claims 2-4, 12-15, 17-19, 27-30, 33, and 38-40 be withdrawn.

Furthermore, claims 41-43 recite, “wherein higher ranking bids are apportioned more presentation resources than lower ranking bids.” It is respectfully submitted that neither *Geller*, *Walker*, nor *Ojha* teaches or suggests at least “wherein higher ranking bids are apportioned more presentation resources than lower ranking bids,” as presented in claims 41-43. In fact, these features are not addressed in the Office Action. The Office Action fails to establish a *prima facie* case of obviousness for claims 41-43. The applied references, taken alone or in combination, fail to teach or suggest each and every claim limitation. Therefore, it is respectfully submitted that the rejection is improper and should be withdrawn.

Claim 44 recites, "apportioning an amount of the presentation resources of the digital device in accordance with the ranking of the information such that higher ranking information is apportioned more presentation resources than lower ranking information." And, claim 45 recites, "wherein the presentation resources include at least one of display space, display duration, and audio duration." It is submitted that the prior art of record does not teach or suggest at least these features. In fact, these features are not addressed in the Office Action. The Office Action fails to establish a *prima facie* case of obviousness for claims 44 and 45. The applied references, taken alone or in combination, fail to teach or suggest each and every claim limitation. Therefore, it is respectfully submitted that the rejection is improper and should be withdrawn.

For at least the above reasons, Applicants request that the rejection of claims 1-45 under 35 U.S.C. § 103 be withdrawn.

### III. Conclusion

It is respectfully urged that the subject application is patentable over the prior art of record and is now in condition for allowance.

The examiner is invited to call the undersigned at the below-listed telephone number if in the opinion of the examiner such a telephone conference would expedite or aid the prosecution and examination of this application.

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